

Amendment for Application No.: 10/672,727  
Attorney Docket: CFA00030US

## **REMARKS**

### **Summary of The Office Action**

The Office Action rejected claims 6, 22, 28 and 34 under 35 USC § 112, first paragraph. The Office Action rejected claims 17-34 and 36 under 35 USC § 101 and 35 USC § 102(b) (under the same rationale as the rejections under 35 USC § 101). The Office Action also rejected all of the Claims (1-36) under 35 USC § 103(a). Each of these rejections and reasons why Applicant believes that the rejections should be reconsidered and withdrawn are discussed below.

The Office Action also included some questions / requests by the Examiner for additional information. Applicant believes that all of the Examiner's questions have been addressed. Applicant requests that the Examiner contact Applicant's representative if the Examiner still has questions.

### **Summary of Amendment**

Claims 1-36 are currently pending in the application. Of these Claims, Claims 1 and 17 are independent claims. Claims 2-16 and 35 are dependent claims depending (either directly or indirectly) from Claim 1 and Claims 18-34 and 36 are dependent claims depending (either directly or indirectly) from Claim 17.

This amendment amends paragraph [0054] of the specification to correct a typographical error. No new matter has been added.

Independent Claims 1 and 17 have also been amended. These claims have not been amended for reasons of patentability, but only for additional clarity (based on the Examiner's questions) of what is inherently obvious based on other limitations within the claim. Therefore, no estoppel should attach based on the amendment of these claims.

### **Rejections Under 35 USC § 112**

Independent Claims 6 and 22 and dependent claims 28 and 34 (which depend from Claim 22) were rejected under 35 USC § 112, first paragraph.

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Office Action, Page 2. More specifically, the Office Action states that Claims 6 and 8 (Applicant believes that this is a typographical error and should have been "22" instead of "8") contain a term "non-linearly" that is not described in the specification. *Id.*

Applicant respectfully disagrees. For example, see paragraph [0076] which is reproduced below:

[0076] According to the embodiment, when the two trimming areas are set on the start screen and on the end screen of the continuous still images and the positions and/or sizes of the two trimming areas are different from each other, they are linearly changed. However, the present invention is not limited to this. For example, the turning moving-image may largely be changed on the start side and it may not be changed so largely on the end side. Alternatively, the turning moving-image may largely be changed on the end side and it may not be changed so largely on the start side. That is, referring to Fig. 14A, the image may linearly be changed as shown by a straight line A from the size in the trimming area designated by the first still image to the size in the trimming area designated by the N-th still image. Alternatively, the change speed of the size may be changed as shown by a curve B and a curve C. For example, in the case of setting the curve B, the end portion of the turning moving-image is acceleratively zoomed. Referring to Fig. 14B, similarly, the size may be set as shown by a straight line A' or it may be set as shown by a curve B' or C'. For example, in the setting of the curve C', the position of the trimming area is changed at a high speed in a start portion of the turning moving-image and it is changed at a low speed in an end portion thereof.

Based on the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 USC § 112, first paragraph.

#### **Rejections Under 35 USC § 101**

Claims 17-34 and 36 were rejected under 35 USC § 101. Office Action, Page 3. The Office Action states that the examiner believes that each of the process claims can be read on mental calculations with the appropriate mathematics and as the only physical steps writing on paper. Therefore, the Examiner believes that, to the extent that those claims require anything physical, they are fully met under 35 USC § 102 by the process of making marks on paper. *Id.*

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As noted in the Office Action, in order to be patentable subject matter, the invention or discovery must come within the boundaries set forth by 35 U.S.C. §101, which permits patents to be granted only for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." The term "process" as defined in 35 U.S.C. §100, means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material. *Id.*

Applicant respectfully submits that the claims meet this standard. The claims are not all mental steps with the only physical steps being writing on paper as alleged in the Office Action.

Applicant respectfully disagrees with the rejection of independent Claim 17 (and dependent Claims 18-34 and 36, which depend from Claim 17) under 35 USC § 101. The essential novelty in the claims at issue in *In re Prater and Wei* were mathematical calculations (which could be done by paper and pencil) and thus, the claims were deemed unpatentable under 35 USC § 101. The claims in the present application are not like those in *In re Prater and Wei*. Applicant respectfully submits that the rejection does not apply to any of the individual claim limitations in the present application, let alone the arrangement (combination) of all of the claim limitations. Therefore, Applicant respectfully submits that the claim rejections under 35 USC § 101 be withdrawn.

#### **Rejections Under 35 USC § 102**

Claims 17-34 and 36 were rejected under 35 USC § 102(b) as being anticipated by, such common means as a pencil, paper, and ruler, since the essential novelty of the claim is the continuous still images." Office Action, Page 4. The rejections under 35 USC § 102(b) are essentially the same as the rejections under 35 USC § 101 (described above). Claims relating to continuous still images are not, as the Examiner alleges, unpatentable by their nature. The rejections of the claims as being anticipated by, "such common means as a pencil, paper, and ruler," are baseless.

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According to 35 USC § 102(b), "a person shall be entitled to a patent unless – (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

As discussed above, the cited "reference" does not teach or suggest each of the claim limitations either alone or as arranged in the claims.

Based on the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 USC §102.

### **Rejections Under 35 USC § 103**

Claims 1-36 were rejected under 35 USC § 103(a) as being patentable over Jeong et al. (U.S. Patent No. 6,690,878) (hereinafter, the "Jeong" reference) and further in view of Hieda (U.S. Patent No. 6,204,878) (hereinafter, the "Hieda" reference).

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that a *prima facie* case of obviousness has not been established. There is no motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

Assuming *arguendo* that there was a motivation to combine the Jeong reference and the Hieda reference, the prior art reference (or references when combined) do not teach or suggest all of the claim limitations.

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The Jeong reference is directed to a system of indexing frames so that a user can directly access a specific portion of recorded moving picture data.

The Hieda reference is directed to an image pickup device which receives a signal from an image sensor element and generates a moving image according to the characteristics thereof and a still image according to the characteristics thereof.

The Office Action states that the Jeong reference teaches designating means, setting means and generating means as in Claim 1. Office Action, pages 4-6, i.e., the Office Action alleges that the Jeong reference teaches all of the limitations except for the printing control means. *Id.* The Office Action further states that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hieda's bandwidth of color signal into Jeong's work in order to prevent blotting, color aberration or deterioration in the color reproducibility. Office Action, Page 6.

Applicant respectfully disagrees that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hieda's bandwidth of color signal into Jeong's work in order to prevent blotting, color aberration or deterioration in the color reproducibility. This rationale does not address the fact that the Jeong reference does not teach or suggest printing control means.

Furthermore, as discussed above, in addition to not teaching or suggesting printing control means, the Jeong reference does not teach or suggest other limitations in Claim 1. The Hieda reference also does not teach or suggest these other claim limitations that are not taught or suggested by the Jeong reference.

Applicant respectfully disagrees with the characterization of the Jeong reference with respect to Claim 1 as described below.

The Jeong reference teaches detecting a scene switch in video data, e.g., based on blank frames. The Jeong reference does not teach or suggest "designating means which designates a desired range of moving image data comprising a plurality of frames." Furthermore, the Jeong reference does not teach or suggest "trimming areas." Therefore, the Jeong reference also does not

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teach or suggest "designating means which designates trimming areas of at least two frames from a predetermined number of frames to be cut out from the range designated by said designating means", "setting means which sets the trimming areas of the predetermined number of frames to be cut out based on the trimming areas designated by said designating means", or "generating means which cuts out the predetermined number of frames from the range designated by said designating means, extracts the trimming areas set by said setting means, and generates a predetermined number of continuous still images." The Hieda reference or the combination of the references do not cure the defects of the Jeong reference.

As the cited references either alone or in combination do not teach or suggest all of the limitations of Claim 1, Claim 1 is believed allowable.

Since Claim 1 is believed allowable, all of the claims depending therefrom (namely, Claims 2-16 and 35) are also believed allowable.

Independent Claim 17 is believed allowable for the same reasons as discussed above with reference to Claim 1.

Since Claim 17 is believed allowable, all of the claims depending therefrom (namely, Claims 18-34 and 36) are also believed allowable.

#### **Examiner's Questions**

With respect to Claim 4, the Examiner requested a more detailed explanation of "gradual change", e.g., based on change in luminance value. Office Action, page 7.

"Gradual change" as used in Claim 4 means the "gradual change" in the case when the size of the trimming area designated by two frame images are the same. In this case, only the position of the trimming area is displaced, without changing the size of the trimming area, so that the position moves frame by frame between two frames to create the effect of the camera pan. The extent of the displacement is determined by the number of the frames between the two frames.

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Applicant believes that all of the Examiner's questions / concerns have been addressed herein. If the Applicant has further questions, Applicant requests that the Examiner contact the under-signed representative of Applicant.

### CONCLUSION

Applicant respectfully submits that all of the claims pending in the application meet the requirements for patentability and respectfully requests that the Examiner indicate the allowance of such claims.

Any amendments to the claims which have been made in this response which have not been specifically noted to overcome a rejection based upon prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

If any additional fee is required, please charge Deposit Account Number 502456.

Should the Examiner have any questions, the Examiner may contact Applicant's representative at the telephone number below.

Respectfully submitted,

12/22/05

Date

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